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59

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/433,139	11/03/1999	JOHN G. SAVAGE	8184.00	2123
26889	7590	05/05/2005	EXAMINER	
MICHAEL CHAN NCR CORPORATION 1700 SOUTH PATTERSON BLVD DAYTON, OH 45479-0001			PARTON, KEVIN S	
			ART UNIT	PAPER NUMBER
			2153	

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/433,139

Applicant(s)

SAVAGE ET AL.

Examiner

Kevin Parton

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 01/05/2005 have been fully considered but they are not persuasive. Please see the following reasons and the grounds of rejection below.

2. On page 5, paragraph 4 – page 6, paragraph 1, the applicant argues that the reference to Kanevsky cannot function as the primary reference in the case because it does not specifically identify the system as an ATM but as a POS terminal. The argument is not persuasive because the functions of a POS terminal mirror the functions of an ATM. It is well known in the art for a POS terminal to function with a users card to provide financial transactions with a bank in addition to the transactions between the customer and the merchant. For example, often, at a POS, a customer can pay for an item as well as withdraw additional cash from a bank account with a receipt provided for this transaction. As such, it is operating as an ATM and can function as the primary reference in the case.

3. On page 6, paragraph 3 – page 7, paragraph 1, the applicant demands a citation in the Suer reference to support the motivation to combine the two references. As shown in MPEP section 706.02(j) the motivation to combine should be found “either in the references themselves *or in the knowledge generally available to one of ordinary skill in the art*” (emphasis added). A specific citation from Suer is unnecessary if the motivation is knowledge generally available to one of ordinary skill in the art.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanevsky et al. (USPN 6,334,109) in view of Suer et al. (USPN 6,431,439).

6. Regarding claim 36, Kanevsky et al. (USPN 6,334,109) teaches a system for operating a user device communicating with a transaction device with means for:

- a. Executing a transaction (column 5, lines 36-41).
- b. Preparing data relating to the transaction that has been executed (column 5, lines 36-41). Note that in the reference, a receipt is prepared for the user at a server.
- c. Transferring the prepared data to the user device to provide the customer with an electronic receipt for the transaction (column 5, lines 36-41; column 8, lines 39-40).
- d. Receiving from the user device personal information which is unrelated to the transaction and which is associated with the customer when the electronic receipt is provided (column 2, lines 41-42; column 5, lines 40-43)

- e. Downloading to the user device specific information which is unrelated to the transaction and which is tailored to the customer based upon the received personal information from the user device (column 2, lines 2-7; column 5, lines 44-47).

Although the system disclosed by Kanevsky et al. (USPN 6,334,109) shows substantial features of the claimed invention, it fails to disclose means wherein:

- a. The user device is a portable device, retained by the customer, which establishes a wireless communication with the transaction device.
- b. The transaction device is an Automated Teller Machine (ATM).
- c. The transaction is the dispensation of cash.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Kanevsky et al. (USPN 6,334,109), as evidenced by Suer et al. (USPN 6,431,439).

In an analogous art, Suer et al. (USPN 6,431,439) discloses a system for performing transactions wherein:

- a. The user device is a portable device, retained by the customer, which establishes a wireless communication with the transaction device (column 4, lines 30-34; column 6, lines 44-55).
- b. The transaction device is an Automated Teller Machine (ATM) (column 4, lines 30-34; column 6, lines 44-55).
- c. The transaction is the dispensation of cash (column 6, lines 44-55).

Given the teaching of Suer et al. (USPN 6,431,439), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Kanevsky by employing the provision of personalized information to the user of an ATM and a portable device. This benefits the system because the user of an ATM may be in need of information relating to the area of the machine. Further, the system will address a larger number of users by branching out to ATMs in addition to other points of sale while the user may save the information to the portable device.

7. Regarding claim 37, Kanevsky et al. (USPN 6,334,109) teach all the limitations as applied to claim 36. They further teach means for analyzing the personal information uploaded from the portable device; and storing the analyzed information in a database entry as a customer profile (column 1, lines 63-66; column 5, lines 20-23).

Although the system disclosed by Kanevsky shows substantial features of the claimed invention, it fails to disclose specifically means wherein the user device is retained by the ATM customer.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Kanevsky as evidenced by Suer.

In an analogous art, Suer discloses a system for performing transactions wherein the user device is retained by the ATM customer (column 4, lines 30-34; column 6, lines 44-55).

Given the teaching of Suer, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Kanevsky by sending

the information to a device retained by the customer. This benefits the system by allowing a user to take an advertisement home for later reference.

8. Regarding claim 38, Kanevsky et al. (USPN 6,334,109) teaches a system for operating a user device communicating with a transaction device with means for:

- a. Executing a transaction (column 5, lines 36-41).
- b. Preparing data relating to the transaction that has been executed (column 5, lines 36-41). Note that in the reference, a receipt is prepared for the user at a server.
- c. Transferring the prepared data to the user device to provide the customer with an electronic receipt for the transaction (column 5, lines 36-41; column 8, lines 39-40).
- d. Uploading from the user device personal information (column 2, lines 41-42; column 5, lines 40-43)
- e. Downloading to the user device specific information which is unrelated to the transaction and which is tailored to the customer based upon the uploaded personal information from the user device (column 2, lines 2-7; column 5, lines 44-47).

Although the system disclosed by Kanevsky et al. (USPN 6,334,109) shows substantial features of the claimed invention, it fails to disclose means wherein:

- a. The user device is a portable device, retained by the user, which establishes a wireless communication with the transaction device.
- b. The transaction device is an Automated Teller Machine (ATM).

- c. The transaction is the dispensation of cash.
- d. The uploaded information is specifically schedule information from a calendar program.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Kanevsky et al. (USPN 6,334,109), as evidenced by Suer et al. (USPN 6,431,439).

In an analogous art, Suer et al. (USPN 6,431,439) discloses a system for performing transactions wherein:

- a. The user device is a portable device, retained by the user, which establishes a wireless communication with the transaction device (column 4, lines 30-34; column 6, lines 44-55).
- b. The transaction device is an Automated Teller Machine (ATM) (column 4, lines 30-34; column 6, lines 44-55).
- c. The transaction is the dispensation of cash (column 6, lines 44-55).
- d. The uploaded information is specifically schedule information from a calendar program (column 9, lines 48-52).

Given the teaching of Suer et al. (USPN 6,431,439), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Kanevsky by employing the provision of personalized information to the user of an ATM and a portable device. This benefits the system because the user of an ATM may be in need of information relating to the area of the machine. Further, the system

will address a larger number of users by branching out to ATMs in addition to other points of sale while the user may save the information to the portable device.

9. Regarding claim 39, although the system disclosed by Kanevsky et al. (USPN 6,334,109) (as applied to claim 38) shows substantial features of the claimed invention, it fails to disclose means wherein the specific information downloaded to the portable device retained by the ATM customer relates to events or activities occurring in a location associated with the schedule information.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Kanevsky et al. (USPN 6,334,109), as evidenced by Suer et al. (USPN 6,431,439).

In an analogous art, Suer et al. (USPN 6,431,439) discloses a system for performing transactions wherein the specific information downloaded to the portable device retained by the ATM customer relates to events or activities occurring in a location associated with the schedule information (column 9, lines 48-52).

Given the teaching of Suer et al. (USPN 6,431,439), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Kanevsky et al. (USPN 6,334,109) by employing the presentation of local event information to the user. This benefits the system by allowing the user to learn of local activities that may be of interest.

10. Regarding claim 40, Kanevsky et al. (USPN 6,334,109) teaches a system for operating a user device communicating with a transaction device with means for:

- a. Executing a transaction (column 5, lines 36-41).

- b. Preparing data relating to the transaction that has been executed (column 5, lines 36-41). Note that in the reference, a receipt is prepared for the user at a server.
- c. Transferring the prepared data to the user device to provide the customer with an electronic receipt for the transaction (column 5, lines 36-41; column 8, lines 39-40).
- d. Uploading from the user device recent purchase information (column 2, lines 41-42; column 5, lines 40-47, 50-53)
- e. Downloading to the user device specific information which is unrelated to the transaction and which is tailored to the customer based upon the uploaded personal information from the user device (column 2, lines 2-7; column 5, lines 44-47).

Although the system disclosed by Kanevsky et al. (USPN 6,334,109) shows substantial features of the claimed invention, it fails to disclose means wherein:

- a. The user device is a portable device, retained by the user, which establishes a wireless communication with the transaction device.
- b. The transaction device is an Automated Teller Machine (ATM).
- c. The transaction is the dispensation of cash.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Kanevsky et al. (USPN 6,334,109), as evidenced by Suer et al. (USPN 6,431,439).

In an analogous art, Suer et al. (USPN 6,431,439) discloses a system for performing transactions wherein:

- a. The user device is a portable device, retained by the user, which establishes a wireless communication with the transaction device (column 4, lines 30-34; column 6, lines 44-55).
- b. The transaction device is an Automated Teller Machine (ATM) (column 4, lines 30-34; column 6, lines 44-55).
- c. The transaction is the dispensation of cash (column 6, lines 44-55).

Given the teaching of Suer et al. (USPN 6,431,439), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Kanevsky by employing the provision of personalized information to the user of an ATM and a portable device. This benefits the system because the user of an ATM may be in need of information relating to the area of the machine. Further, the system will address a larger number of users by branching out to ATMs in addition to other points of sale while the user may save the information to the portable device.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

Art Unit: 2153

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

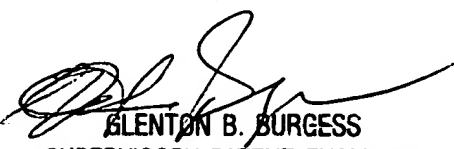
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Parton whose telephone number is (571)272-3958. The examiner can normally be reached on M-F 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571)272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin Parton
Examiner
Art Unit 2153

ksp


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